

DOCKET NO.: 3805-016-27CIP



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

IN RE APPLICATION OF: Mark Edward KANE, et al. ART UNIT: 3661  
SERIAL NO.: 10/609,377 EXAMINER: Cuong H. Nyugen  
FILING DATE: July 1, 2003  
FOR: METHOD AND SYSTEM FOR COMPENSATING FOR WHEEL WEAR ON A TRAIN

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

COMMISSIONER FOR PATENTS  
PO BOX 1450  
ALEXANDRIA, VA 22313-1450

SIR:

Applicant request review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the:

- ☐ applicant/inventor.  
☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
☒ attorney or agent of record.  
Registration No.: 41,828  
☐ attorney or agent acting under 37 CFR 1.34.  
Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*

- ☒ \*Total of       FIVE       forms are submitted.

Respectfully submitted,

DLA PIPER RUDNICK GRAY CARY US LLP

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

IN RE APPLICATION OF: Mark Edward KANE, et al. ART UNIT: 3661  
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**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

ASSISTANT COMMISSIONER FOR PATENTS  
PO BOX 1450  
ALEXANDRIA, VA 22313-1450

SIR:

Applicants hereby request, pursuant to the pilot program described at 1296 Off. Gaz. 67 (July 12, 2005, as extended on January 11, 2006), pre-appeal brief review of the outstanding rejection of claims 1-24 of the instant application under 35 U.S.C. § 103 over the combination of Kumar (U.S. Pat. No. 6,148,269), Matsuno (U.S. Pat. No. 6,219,609), Bidaud (U.S. Pat. No. 6,347,265) and Bingeman (U.S. Pat. No. 6,446,005). The current version of claims 1-24 is reflected in Applicants' Amendment submitted on August 23, 2005. Applicants' position with respect to each of the rejected claims is set forth succinctly below:

**Claims 1-14**

Claim 1 is directed toward a method of determining a wheel size that includes the steps of "determining a linear distance traveled by a train during a period of time by calculating a difference in positions reported by a positioning system located on the train at a start of the period and an end of the period," "repeating the determining step a plurality of times," "adding the linear distance from each of the determining steps to form a total

distance,” and “calculating the wheel size based on the total distance and a total number of wheel revolutions occurring during each of the determining steps.” Claim 8 includes similar limitations. Claims 2-7 and 9-14 depend from claims 1 and 8, respectively.

In the previous rejection dated May 23, 2005, the examiner relied on the combination of Kumar, Matsuno and Bidaud to reject these claims. None of these references discloses the steps of claim 1 discussed above for the reasons set forth in Applicants Amendment dated August 23, 2005. In his latest rejection dated November 3, 2005, the examiner adds Bingeman, which the examiner claims discloses “adding segments of distance to obtain a total distance.” The examiner cites claim 6 of Bingeman as support for this proposition. However, claim 6 of Bingeman reads: “The location determining system of claim 5, wherein said housing is electrically insulated from the chassis of said golf cart.” This clearly has nothing to do with “adding segments of distance to obtain a total distance.”

Applicants have reviewed Bingeman in detail and cannot locate anything in Bingeman that remotely discloses the concept of calculating a total distance comprised of a plurality of linear distances calculated using differences in positions reported by a positioning system as required by claims 1 and 8. The most relevant portion of Bingeman appears to be the discussion of the calculation of errors in the calculation of a wheel scale factor at col. 17, line 52 – col. 18, line 3. However, this passage does not contain any disclosure of calculating a total distance comprised of a plurality of linear distances calculated using differences in positions reported by a positioning system as required by claims 1 and 8. Accordingly, applicants respectfully request withdrawal of the rejection of claims 1-14.

Applicants further note that the examiner made the rejection of these claims final despite the fact that he changed the basis of the rejection. As discussed above, the first rejection dated May 23, 2005 relied on the combination of Kumar, Matsuno and Bidaud, but

the second rejection dated November 3, 2005 relied on the combination of Kumar, Matsuno and Bidaud and Bingeman. The examiner cited MPEP 706.07(a) as authority for making his rejection final, but that section clearly states that a rejection cannot be made final where an examiner “introduces a new ground of rejection that is neither necessitated by applicant’s amendment of claims nor based on information submitted in an information disclosure statement.” Applicants note that claims 1 and 8 are in their original form and that all of the references relied on by the examiner were known to him as of the date of the first office action on May 23, 2005. Accordingly, applicants respectfully request that the examiner be advised that, in the event that a Notice of Allowance is not forthcoming, the next rejection of claims 1-14 should not be made final.

#### Claims 15-21

Although the limitations of claim 15 are quite different from claim 1, the examiner has never separately addressed these claims. Claim 15 requires “determining a wheel size based on the rotation information and the speed.” The examiner has never identified any reference as disclosing this step. Accordingly, Applicants respectfully request withdrawal of the rejection.

#### Claims 22-24

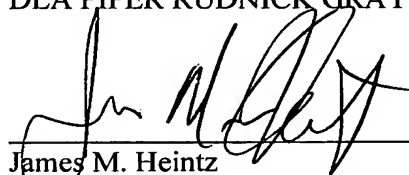
Claims 22-24 are directed toward an embodiment of the invention discusses at page 11, line 9 – page 13, line 12. Each of these claims requires the step of “generating a parameter of a signal that would be output by a wheel sensor connected to a wheel of a predetermined size if the wheel were on the train,” “generating a corrected wheel sensor signal having the parameter,” and “supplying the corrected wheel sensor signal to at

least one device configured to accept a wheel sensor signal from a wheel sensor connected to a wheel of the predetermined size.” Again, the examiner has never separately addressed these limitations, relying instead on his rejection of claim1. Because the examiner has not identified any disclosure of the foregoing steps in any of the cited references, Applicants respectfully request withdrawal of the rejection of claims 22 and 24.

In light of the foregoing Applicants submit that this application is now in condition for allowance and therefore request favorable consideration. If any issues remain which the Examiner feels may be best resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact Applicants counsel, James M. Heintz at 202.861.4167.

Respectfully submitted,

DLA PIPER RUDNICK GRAY CARY US LLP

A handwritten signature in black ink, appearing to read 'J. M. Heintz', is written over a horizontal line.

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